

ESTTA Tracking number: **ESTTA598835**

Filing date: **04/16/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Rexel Developpement SAS
Granted to Date of previous extension	04/16/2014
Address	13 Boulevard du Fort de Vaux Paris, 75017 FRANCE
Attorney information	ROBERT A BECKER FROSS ZELNICK LEHRMAN & ZISSU PC 866 UNITED NATIONS PLAZA NEW YORK, NY 10017 UNITED STATES rbecker@frosszelnick.com Phone:212-813-5900

### Applicant Information

Application No	85811637	Publication date	12/17/2013
Opposition Filing Date	04/16/2014	Opposition Period Ends	04/16/2014
International Registration No.	NONE	International Registration Date	NONE
Applicant	REXANT INTERNATIONAL LIMITED RM 1115, 11/F., WING ON PLAZA KOWLOON, HONG KONG, HKX HKX		

### Goods/Services Affected by Opposition

<p>Class 008. First Use: 0 First Use In Commerce: 0</p> <p>All goods and services in the class are opposed, namely: Hand-operated tools and implements, namely, cable and wire cutters, strippers, crimpers, terminators, connectors crimping tools, connector removal tools, jack termination tools, punch down and impacttools, cable tie guns, insertion and extraction tools, riveting hand tools, insulation displacement crimping hand tools, dies impact tools, screw fastening tools, beard clippers, electric hair clippers for personal use and for animals, non-electric hair clippers for personal useand for animals, shears, cattle shears;cutlery; razors</p>
<p>Class 009. First Use: 0 First Use In Commerce: 0</p> <p>All goods and services in the class are opposed, namely: Measuring, signalling, checking apparatus and instruments, namely, ammeters, ohmmeters, voltmeters, frequency meters, multi-meters, AC volt detectors, moisturedetectors, distance meters, stud detectors, metal detectors, batteries testers, network multi-modular cable testers, antennas, satellite finder, signal receivers, signal splitters; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, electricaland electronic cables and wires, copperand aluminum power cables, security cables, fire alarm cables, communications cables and wires, lan cables,</p>

coaxial cables, speaker cables, microphone cables, telephone cables, optical fiber cables, circuit closers, connectors for electricity, electric contacts, fuses, breakers, distribution boards, distribution boxes, distribution consoles, junction boxes, electricity conduits, sockets and plugs for electric connections, electric switches, switchboards, terminals for electricity, accumulators, batteries for electric, galvanic cells and batteries, chargers for electric batteries, battery boxes, solar batteries, circuit breakers, electric converters, switchboxes, transformers; apparatus for recording, transmission or reproduction of sound or images


Class 017. First Use: 0 First Use In Commerce: 0

All goods and services in the class are opposed, namely: Plastics in extruded form for use in manufacture; packing and insulating materials; flexible pipes, not of metal

## Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
--------------------------------------	----------------------------


## Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3656343	Application Date	03/28/2007
Registration Date	07/21/2009	Foreign Priority Date	10/03/2006
Word Mark	REXEL		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 007. First use: First Use: 0 First Use In Commerce: 0 electric are welding machines</p> <p>Class 009. First use: First Use: 0 First Use In Commerce: 0 electric apparatuses and instruments, namely, apparatuses and instruments for conveying, distributing, transforming, storing, regulating or controlling electrical current; electrical couplings, accumulator jars; cases for accumulators; acidimeter for accumulators; chargers for electrical batteries; reels of electromagnets; electrical coils; holders for electrical coils; cathode ray tubes; photo voltaic cells; electronic components, namely, integrated circuits, semiconductors, diodes, for electronic installations, heat regulating device, namely, heat regulators; electric circuit breakers; flashing safety lights; bar code scanners; electrical commutators; electric installations, namely, wireless electronic and testing equipment for the remote control of industrial operations; electric devices and installations, namely, remote controllers for the remote control of electrical appliances, air conditioning and heating appliances, and lighting equipment; electric switches; electrical appliance for commutation, namely, electrical commutators, electrical supply sockets; electric terminals; distribution boxes for electricity; cable joint boxes for electricity; plug board boxes and electric plug boards; electrical cables for use in connections and electrical contacts; electrical contacts of precious metal; electrical connectors; electric connectionboxes; electrical socket cover; electric control panels; power-</p>		

	<p>lines transmission machines and apparatus; electric metering device, namely, electric meters and electric metering equipment, detectors, electric adapters, power adaptors for apparatus and goods for lighting, heating, air conditioning and air cooling and household electrical appliances and for apparatus and instruments for conducting, switching, connecting, transforming, accumulating, regulating, measuring or controlling electricity, namely, electric cables and electric ducts; electric transformers; electric circuit breakers, electric contractors and switches; electrical inductors; electrical armatures; electrical relays; rheostats; over-voltage protection controllers; electric choke coils; semi conductors; temperature regulators; current rectifiers, electronic pencils, devices, namely, distribution consoles for switching electricity for the distribution of electricity to be stored in desks; devices, namely, electricity distribution boxes for the distribution of electricity to be stored in cupboard; distribution boxes for electricity; fuses; lightning protectors, namely, lightning rods, electrical lightning conductors; antennas and electric or electronic instruments of safety, namely, cameras, security panels, burglar alarms and security passive infra red and glass break sensors for movement or noise; sirens; electronic chimes for doors; electric buzzers; metal detectors for industrial or military purposes; smoke detectors; water level indicators; magnetic encoders; microphones; sound amplifiers; loudspeakers; cases for loudspeakers; audible warning devices, namely, acoustic alarms; warning signals, namely, anti-theft warning apparatus for sirens and audible warning devices connected to security systems; fire alarms; luminous beacons that act as lights; ballasts for lighting purposes; electronic luminous panels and mechanical signaling panels; luminous tubes for lighting for publicity; flash bulbs, flash lamps; optical lamps; thermionic lamps; fluorescent screens; optical lanterns for lightning purposes; electrical soldering iron; galvanic batteries; rechargeable electric batteries; batteries; battery for flashlights; power supplies; video and audio compact disc players; electric card readers and electronic locks with codes; electric devices for opening doors, namely, electric door openers, electric and electronic entrance intercoms; coin operated gates for car parks or parking lots; electrical or electronic appliances, namely, analog or digital voltage detectors and measurement devices for monitoring consumption of electric, domestic and industrial power instruments, namely, electric energy meters, electrical energy utilization metering devices, both remote and installed; electrical or electronic appliance for analysis of signals current and voltage, namely, test and measurement equipment, automation devices and remote monitoring equipment; devices, namely, apparatus for testing, measuring and capturing equipment, namely, metering equipment for testing measuring and capturing information on energy usage and quality; automation devices and remote monitoring equipment, namely, data recorders and data relays for electrical test and measurement equipment for counting, collecting, storing, converting, processing, entering, broadcasting, transmitting data, information and signals, namely, data processors and electronic relays for sensors; telebreakers; measuring devices and instruments, namely, handheld voltage current and wave form measurement devices, namely, handled voltage, current and wave form measurement equipment; volt meters; ammeters; frequency meters; temperature indicators; speed indicators; electricity conduits; high power electric cables; rigid electronic wire; conducting wire for luminous rays; flexible and extra flexible electric cable; insulated copper wire; coaxial cables; non-flammable electric cables; magnetic telephone wire, magnetic telephone safety wire and electric television cables; protected sheaths for electric cables; optical fiber cables, electrical and electronic devices for electrical and computer wiring, namely, category 5, Se, 6, 6e coaxial cables and their future enhancements, coaxial and other data transmission cable, and their associated insulation and termination products for electronic and IT wiring, namely, computer and data transmission and telephone cables; computer cables and electrical sockets for computer equipment; electrical and electronic appliances, namely, electrical outlet testers and continuity test apparatus for electrical circuits for testing IT and electric wiring; electric cable testers and electronic cable testers; electric convener;</p>
--	---

	<p>junction sleeves for electric cables; connections for electric lines; electrical identification wire forelectric wires; magnetic wires; magnetic telephone wires; electric and optical connection wires; electronic indicator panels of electric loss; electronic indicator boards; antennas; anti-interferencedevices, namely, interferon meters and filters for radio interference suppression; control devices for elevators, namely, electric controller to manage power, movement and function of elevator; optical character readers, knee pads for workmen, protective work gloves, protectivegloves for industrial use, namely, protective gloves for protection against accidents; safety goggles, gas masks; protective eyepieces; protective helmets; shoes for protection against accidents, irradiation and fire</p> <p>Class 011. First use: First Use: 0 First Use In Commerce: 0</p> <p>electric lighting fixtures, namely, power failure back-ups safety lighting; lanterns, namely, electric lanterns; chandeliers; flashlights; lighting lamps; electric lights for Christmas trees and aquariums; floor lamps; laboratory lamps; safety lamps for underground use; filaments for electric lamps; electric heating filaments; arc lamps; lamp hanging supports; lamp reflectors, lamp shades; ceiling lights; luminous tubes for lighting; sockets for electric lights; electric flashlights for lighting; electric pocket search lights; lighting diffusers; tubes with electric discharges for lighting; sun lamps for cosmetic use; lighting bulbs; fluorescent lighting tubes, electric bulbs, devices and installations for drying, namely, electric hand drying apparatus for wash rooms; dryers, namely, electric hot air hand dryers; heating appliances, namely, heating furnaces; electricradiators, not for motors and engines; humidifiers for central heating radiators, radiators; hot water heaters; heat recovery machines; heat exchangers not being parts of machines; heaters for baths;hot plates; heating plates; solar collector; heat accumulators and heat regenerators; ionization devices for air treatment, namely, water ionizes for householdpurposes; air cleaning devices and machines, namely, air clearing units containing an air filter; air deodorization devices, namely, electric air deodorizers; air cooling devices, namely, evaporativeair coolers, electric air conditioning fans; ventilating fans for commercial and industrial use, ventilation hoods; extractor hoods for kitchens; electric cooking stoves; freezers; ice making machines, refrigerators, cold combustion chambers, electric lanterns with signals; air conditioning units; lamps for projectors</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0</p> <p>Wholesale store services, retail store services and online retail store services featuring devices and instruments for operation, distribution, connection, transformation, accumulation, adjustment, measurement, monitoring control of the electrical current, including cables and conduits; wholesale store services, retail store services and online retail storeservices featuring devices and productsfor lighting, heating, air conditioning, air cooling and household appliance; wholesale store services, retail store services and online retail store services featuring tools and instruments to cut, cut-out, bore, measure, tighten, crimp, unroll, strip and draw wires, sheaths and cables to weld, crimp file, build, actuated manually or electronically; wholesale store services, retail store services and online retail store services, featuring screws, bolts and products for mechanical or chemical fixing; wholesale store services, retail store services and online retail store services, featuring flexible pipes, insulator or insulating products and materials; wholesale store services and retail store services including by way of telecommunications and ordata processing networks featuring devices and instrument for monitoring of safety of people, goods, site access; wholesale store services, retail store services and online retail store services featuring devices and insulations for home automation, building automation and industrial automatisms; wholesale store services, retail store services and online retail store services featuring IT equipment including data processing peripherals, connection cables and sockets for IT materials and installations; business organization and management consultancy; advertising servicing; conducting marketing studies; arranging and conducting trade show</p>
--	---

	<p>exhibitions in the field of electric and industrial equipment for commercial or publicity purposes, organizing profession markets, namely, job fairs for commercial or publicity purposes; purchasing agent services, namely, purchasing of products for others and business advice and analysis, namely, procurement and purchasing industrial equipment likely to meet the technical requirements defined in technical specification</p> <p>Class 036. First use: First Use: 0 First Use In Commerce: 0</p> <p>corporate financing services; investment services, namely, management of portfolios of financial interest; asset and real estate management</p> <p>Class 037. First use: First Use: 0 First Use In Commerce: 0</p> <p>installation, maintenance and repair of electric devices and installation, electronic motors, panel boards and PLC's and the associated programming of the se products; installation, maintenance and repair of devices and products, namely, electric motors, panel boards, PLL's and the associated programming of these products for lightning, heating, air conditioning cooling of air and household appliances; installation, maintenance and repair of alarm access control and monitoring devices installations for home, automation, building automation, and industrial automatism; rental of hand and power tools, electric and band operated, namely, tools and instruments for cutting, cropping, drilling, measuring, tightening, crimping, uncoiling, stripping and pulling wires, sheaths and cables for welding filling and brick laying; rental of apparatus and instruments, namely, hand and power tools for conducting, transforming, accumulating, regulating or controlling electricity</p> <p>Class 039. First use: First Use: 0 First Use In Commerce: 0</p> <p>Rental of devices and instruments for the distribution of electricity</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0</p> <p>Technical advice, technical consultation and technical research in the field of the design and development of material and installations for operation, distribution, transformation, accumulation, adjustment, measurement, control or the ordering of the electrical current; technical advice and technical consultation and technical research in the field the design and development of devices, material and installations for lighting, ventilation, heating or cooling of air; advice, consultation and technical research in the field the design and development of home automation, building automation and industrial automatisms; technical advice, technical consultation and technical research in the field of the design and development of devices for safety and distance monitoring of persons and goods, industrial facilities or service activities and private residences; technical research in the field of technology with respect to need assessment in terms of electric material and installation, including cables, in terms of air heating and cooling, house automation, building automation, industrial automatisms, safety and monitoring; technical consultation and research in the field of testing of new products for others, as it relates to technical performance evaluation, compatibility analysis and the possibilities of integration of electric materials in complex electric installations; technical analysis of products for others to determine how to make them more environmentally sound and consulting services in the field of the selection of electrical and industrial equipment, namely, computer hardware and software systems, likely to meet the technical requirements defined in a technical specification; providing technological information in the field of electric materials, devices, and installations, electrically operated materials and devices, electric monitoring systems, home automation systems, alarm monitoring systems, electronic access control systems, electronic building information systems, and electronic industrial automation systems; providing technological information in the field of electric materials, devices, and installations, electrically operated materials and devices, electric monitoring systems, home automation systems, alarm monitoring systems, electronic access control systems, electronic building information systems, and electronic industrial automation systems via the Internet; providing technological</p>
--	--

	information in the field of devices and installations for lighting electronic operation, heating and air conditioning and lighting for street signs; providing technological information in the field of devices and installations for lighting electronic operation, heating and air conditioning and lighting for street signs via the Internet		
U.S. Registration No.	3656345	Application Date	03/28/2007
Registration Date	07/21/2009	Foreign Priority Date	10/03/2006
Word Mark	REXEL		
Design Mark			
Description of Mark	The mark consists of the word "REXEL" which is stylized in white sitting in a blue rectangle, which has a rounded upper right corner. There is a thin white line segment there below that separates a smaller orange rectangle with a rounded lower left corner beneath that.		
Goods/Services	<p>Class 007. First use: First Use: 0 First Use In Commerce: 0 Electric arc welding machines</p> <p>Class 009. First use: First Use: 0 First Use In Commerce: 0 electric apparatuses and instruments, namely, apparatuses and instruments for conveying, distributing, transforming, storing, regulating or controlling electrical current; electrical couplings, accumulator jars; cases for accumulators; acidimeter for accumulators; chargers for electrical batteries; reels of electromagnets; electrical coils; holders for electrical coils; cathode ray tubes; photo voltaic cells; electronic components, namely, integrated circuits, semiconductors, diodes, for electronic installations, heat regulating device, namely, heat regulators; electric circuit breakers; flashing safety lights; bar code scanners; electrical commutators; electric installations, namely, wireless electronic and testing equipment for the remote control of industrial operations; electric devices and installations, namely, remote controllers for the remote control of electrical appliances, air conditioning and heating appliances, and lighting equipment; electric switches; electrical appliance for commutation, namely, electrical commutators, electrical supply sockets; electric terminals; distribution boxes for electricity; cable joint boxes for electricity; plug board boxes and electric plug boards; electrical cables for use in connections and electrical contacts; electrical contacts of precious metal; electrical connectors; electric connection boxes; electrical socket cover; electric control panels; power-lines transmission machines and apparatus; electric metering device, namely, electric meters and electric metering equipment, detectors, electric adapters, power adaptors for apparatus and goods for lighting, heating, air conditioning and air cooling and household electrical appliances and for apparatus and instruments for conducting, switching, connecting, transforming, accumulating, regulating, measuring or controlling electricity, namely, electric cables and electric ducts; electric transformers; electric circuit breakers, electric contractors and switches; electrical inductors; electrical armatures; electrical relays; rheostats; over-voltage protection controllers; electric choke coils; semi</p>		

	<p>conductors; temperature regulators; current rectifiers, electronic pencils, devices, namely, distribution consoles for switching electricity for the distribution of electricity to be stored in desks; devices, namely, electricity distribution boxes for the distribution of electricity to be stored in cupboard; distribution boxes for electricity; fuses; lightning protectors, namely, lightning rods, electrical lightning conductors; antennas and electric or electronic instruments of safety, namely, cameras, security panels, burglar alarms and security passive infra red and glass break sensors for movement or noise; sirens; electronic chimes for doors; electric buzzers; metal detectors for industrial or military purposes; smoke detectors; water level indicators; magnetic encoders; microphones; sound amplifiers; loudspeakers; cases for loudspeakers; audible warning devices, namely, acoustic alarms; warning signals, namely, anti-theft warning apparatus for sirens and audible warning devices connected to security systems; fire alarms; luminous beacons that act as lights; ballasts for lighting purposes; electronic luminous panels and mechanical signaling panels; luminous tubes for lighting for publicity; flash bulbs, flash lamps; optical lamps; thermionic lamps; fluorescent screens; optical lanterns for lightning purposes; electrical soldering iron; galvanic batteries; rechargeable electric batteries; batteries; battery for flashlights; power supplies; video and audio compact disc players; electric card readers and electronic locks with codes; electric devices for opening doors, namely, electric door openers, electric and electronic entrance intercoms; coin operated gates for car parks or parking lots; electrical or electronic appliances, namely, analog or digital voltage detectors and measurement devices for monitoring consumption of electric, domestic and industrial power instruments, namely, electric energy meters, electrical energy utilization metering devices, both remote and installed; electrical or electronic appliance for analysis of signals current and voltage, namely, test and measurement equipment, automation devices and remote monitoring equipment; devices, namely, apparatus for testing, measuring and capturing equipment, namely, metering equipment for testing measuring and capturing information on energy usage and quality; automation devices and remote monitoring equipment, namely, data recorders and data relays for electrical test and measurement equipment for counting, collecting, storing, converting, processing, entering, broadcasting, transmitting data, information and signals, namely, data processors and electronic relays for sensors; telebreakers; measuring devices and instruments, namely, handheld voltage current and wave form measurement devices, namely, handled voltage, current and wave form measurement equipment; volt meters; ammeters; frequency meters; temperature indicators; speed indicators; electricity conduits; high power electric cables; rigid electronic wire; conducting wire for luminous rays; flexible and extra flexible electric cable; insulated copper wire; coaxial cables; non-flammable electric cables; magnetic telephone wire, magnetic telephone safety wire and electric television cables; protected sheaths for electric cables; optical fiber cables, electrical and electronic devices for electrical and computer wiring, namely, category 5, Se, 6, 6e coaxial cables and their future enhancements, coaxial and other data transmission cable, and their associated insulation and termination products for electronic and IT wiring, namely, computer and data transmission and telephone cables; computer cables and electrical sockets for computer equipment; electrical and electronic appliances, namely, electrical outlet testers and continuity test apparatus for electrical circuits for testing IT and electric wiring; electric cable testers and electronic cable testers; electric convener; junction sleeves for electric cables; connections for electric lines; electrical identification wire for electric wires; magnetic wires; magnetic telephone wires; electric and optical connection wires; electronic indicator panels of electric loss; electronic indicator boards; antennas; anti-interference devices, namely, interferon meters and filters for radio interference suppression; control devices for elevators, namely, electric controller to manage power, movement and function of elevator; optical character readers, knee pads for workmen, protective work gloves, protective gloves for industrial use, namely, protective gloves for protection against accidents; safety goggles, gas masks; protective</p>
--	---

	<p>eyepieces; protective helmets; shoes for protection against accidents, irradiation and fire</p> <p>Class 011. First use: First Use: 0 First Use In Commerce: 0</p> <p>electric lighting fixtures, namely, power failure back-ups safety lighting; lanterns, namely, electric lanterns; chandeliers; flashlights; lighting lamps; electric lights for Christmas trees and aquariums; floor lamps; laboratory lamps; safety lamps for underground use; filaments for electric lamps; electric heating filaments; arc lamps; lamp hanging supports; lamp reflectors, lamp shades; ceiling lights; luminous tubes for lighting; sockets for electric lights; electric flashlights for lighting; electric pocket search lights; lighting diffusers; tubes with electric discharges for lighting; sun lamps for cosmetic use; lighting bulbs; fluorescent lighting tubes, electric bulbs, devices and installations for drying, namely, electric hand drying apparatus for washrooms; dryers, namely, electric hot air hand dryers; heating appliances, namely, heating furnaces; electric radiators, not for motors and engines; humidifiers for central heating radiators, radiators; hot water heaters; heat recovery machines; heat exchangers not being parts of machines; heaters for baths; hot plates; heating plates; solar collector; heat accumulators and heat regenerators; ionization devices for air treatment, namely, water ionizes for household purposes; air cleaning devices and machines, namely, air clearing units containing an air filter; air deodorization devices, namely, electric air deodorizers; air cooling devices, namely, evaporative air coolers, electric air conditioning fans; ventilating fans for commercial and industrial use, ventilation hoods; extractor hoods for kitchens; electric cooking stoves; freezers; ice making machines, refrigerators, cold combustion chambers, electric lanterns with signals; air conditioning units; lamps for projectors</p> <p>Class 035. First use: First Use: 0 First Use In Commerce: 0</p> <p>Wholesale store services, retail store services and online retail store services featuring devices and instruments for operation, distribution, connection, transformation, accumulation, adjustment, measurement, monitoring control of the electrical current, including cables and conduits; wholesale store services, retail store services and online retail store services featuring devices and products for lighting, heating, air conditioning, air cooling and household appliance; wholesale store services, retail store services and online retail store services featuring tools and instruments to cut, cut-out, bore, measure, tighten, crimp, unroll, strip and draw wires, sheaths and cables to weld, crimp file, build, actuated manually or electronically; wholesale store services, retail store services and online retail store services, featuring screws, bolts and products for mechanical or chemical fixing; wholesale store services, retail store services and online retail store services, featuring flexible pipes, insulator or insulating products and materials; wholesale store services and retail store services including by way of telecommunications and or data processing networks featuring devices and instrument for monitoring of safety of people, goods, site access; wholesale store services, retail store services and online retail store services featuring devices and insulations for home automation, building automation and industrial automatisms; wholesale store services, retail store services and online retail store services featuring IT equipment including data processing peripherals, connection cables and sockets for IT materials and installations; business organization and management consultancy; advertising servicing; conducting marketing studies; arranging and conducting trade show exhibitions in the field of electric and industrial equipment for commercial or publicity purposes, organizing profession markets, namely, job fairs for commercial or publicity purposes; purchasing agent services, namely, purchasing of products for others and business advice and analysis, namely, procurement and purchasing industrial equipment likely to meet the technical requirements defined in technical specification</p> <p>Class 036. First use: First Use: 0 First Use In Commerce: 0</p> <p>corporate financing services; investment services, namely, management of</p>
--	---



	<p>portfolios of financial interest; asset and real estate management</p> <p>Class 037. First use: First Use: 0 First Use In Commerce: 0</p> <p>Installation, maintenance and repair of electric devices and installation, electronic motors, panel boards and PLC's and the associated programming of these products; installation, maintenance and repair of devices and products, namely, electric motors, panel boards, PLL's and the associated programming of these products for lightning, heating, air conditioning cooling of air and household appliances; installation, maintenance and repair of alarm access control and monitoring devices installations for home, automation, building automation, and industrial automatism; rental of hand and power tools, electric and hand operated, namely, tools and instruments for cuffing, cropping, drilling, measuring, tightening, crimping, uncoiling, stripping and pulling wires, sheaths and cables for welding filling and brick laying; rental of apparatus and instruments, namely, hand and power tools for conducting, transforming, accumulating, regulating or controlling electricity</p> <p>Class 039. First use: First Use: 0 First Use In Commerce: 0</p> <p>Rental of devices and instruments for the distribution of electricity</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0</p> <p>Technical advice, technical consultation and technical research in the field of the design and development of material and installations for operation, distribution, transformation, accumulation, adjustment, measurement, control or the ordering of the electrical current; technical advice and technical consultation and technical research in the field the design and development of devices, material and installations for lighting, ventilation, heating or cooling of air; advice, consultation and technical research in the field the design and development of home automation, building automation and industrial automatisms; technical advice, technical consultation and technical research in the field of the design and development of devices for safety and distance monitoring of persons and goods, industrial facilities or service activities and private residences; technical research in the field of technology with respect to need assessment in terms of electric material and installation, including cables, in terms of air heating and cooling, house automation, building automation, industrial automatisms, safety and monitoring; technical consultation and research in the field of testing of new products for others, as it relates to technical performance evaluation, compatibility analysis and the possibilities of integration of electric materials in complex electric installations; technical analysis of products for others to determine how to make them more environmentally sound and consulting services in the field of the selection of electrical and industrial equipment, namely, computer hardware and software systems, likely to meet the technical requirements defined in a technical specification; providing technological information in the field of electric materials, devices, and installations, electrically operated materials and devices, electric monitoring systems, home automation systems, alarm monitoring systems, electronic access control systems, electronic building information systems, and electronic industrial automation systems; providing technological information in the field of electric materials, devices, and installations, electrically operated materials and devices, electric monitoring systems, home automation systems, alarm monitoring systems, electronic access control systems, electronic building information systems, and electronic industrial automation systems via the Internet; providing technological information in the field of devices and installations for lighting electronic operation, heating and air conditioning and lighting for street signs; providing technological information in the field of devices and installations for lighting electronic operation, heating and air conditioning and lighting for street signs via the Internet</p>		
U.S. Registration No.	4409034	Application Date	07/11/2012

Registration Date	10/01/2013	Foreign Priority Date	NONE
Word Mark	REXEL ENERGY IN MOTION		
Design Mark	<b>Rexel Energy in motion</b>		
Description of Mark	NONE		
Goods/Services	<p>Class 035. First use: First Use: 0 First Use In Commerce: 0</p> <p>Wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring apparatus and instruments for conducting, switching, connecting, transforming, accumulating, regulating, measuring, checking or controlling electricity, including electrical conduits and cables; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring apparatus and goods for lighting, heating, air conditioning, air cooling and for electric household appliances; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring tools and instruments for cutting, chopping, drilling, measuring, clamping, unwinding, stripping and drawing wires, sheaths and cables for soldering, crimping, filing and for laying bricks, manually or electrically operated; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring fastening and bolting products and for mechanical or chemical affixing products; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring goods for dusting, cleaning, wiping, galvanizing, lubricating, unjamming, greasing, varnishing, dehumidifying and protecting against humidity and local cooling; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring flexible tubes, insulating goods and materials; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring apparatus and instruments for surveillance and security of persons, property, access points and sites; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring apparatus and installations for home automation, building automation and industrial process controls; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring apparatus for recording, transmitting, reproducing sound, images or data including apparatus and instruments for communication; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring computer hardware including computer peripheral devices, cables and connector plugs for computer hardware and installations; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring downloadable electronic publications; business management and organization consultancy; business administration; consultancy relating to commercial strategy and consulting relating to commercial management and development; professional business consultancy and providing business information; conducting marketing studies; organization of trade shows, exhibitions, trade fairs and job fairs for commercial or advertising purposes; business and marketing commercial analysis in the nature of shortlisting of products for others and commercial consultancy in the field of electrical and industrial equipment likely to meet technical requirements defined in a technical project specification; dissemination of advertisements; direct mail advertising services; organization of promotional and advertising activities for developing customer loyalty; business efficiency expert services; commercial or industrial business management assistance; data processing services, namely, administrative processing of purchase orders; commercial information and advice for consumers; computerized file management; collection and systemization of data into computer databases; compilation of statistics; promoting the goods and services</p>		

	<p>of others by means of the issuance of loyalty cards for commercial purposes enabling the acquisition of discount vouchers</p> <p>Class 036. First use: First Use: 0 First Use In Commerce: 0</p> <p>Financial affairs, namely, credit and financial consultation, financial forecasting, financial planning, monetary affairs, namely, acquisition and transfer of monetary claims, money order services, and real estate affairs, namely, real estate escrow services, real estate listing, real estate investment; providing financial information, investigations, forecasts and expert appraisals on real estate and personal property of others; capital investment services, namely, capital raising, investment and placement; venture capital advisory services and fund management and financing services; corporate financing services; financial consulting in the context of mergers, acquisitions, stock exchange listings for companies; financial consulting and advising related to acquisition of financial interests in commercial enterprises and companies; management and administration of portfolios of financial interests; financial consulting and expert appraisals for management of capital interests held in listed or unlisted companies; financial asset and real estate management; surety services; provision and financial management of cash savings accounts; management of financial benefits associated with the use of a loyalty card, namely, loyalty program payment processing services</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0</p> <p>Technical advisory, consulting and research services in the field of equipment and installations for conducting, switching, transforming, accumulating, regulating, measuring or controlling electricity; technical advisory, consulting and research services in the field of apparatus, equipment and installations for lighting, ventilating, heating or air cooling; technical advisory, consulting and research services in the field of home automation, building automation and industrial process controls; technical research in the field of security and remote monitoring of persons and goods, industrial installations or service activities and private residences; technical project studies on evaluating requirements, namely, technical diagnostics, with respect to electrical equipment and installations, including cables, relating to heating and air cooling, home automation, building automation, industrial process controls, security and monitoring; technical consulting and technical studies to evaluate technical performance, to analyze accounting and options for integrating electrical equipment into complex electrical installations; technical design of new products and services for others in the field of electrical equipment and installations, and in the field of tools; technical project studies, analyses and diagnostics for the implementation and commissioning of electrical apparatus and installations; design and development including technical analysis of products for others and technical consulting in the choice of electrical and industrial equipment likely to meet technical requirements defined in a technical project specification; providing technical information, particularly on-line or on telecommunication and/or computer networks, with regard to electrical equipment, apparatus and installations, with regard to equipment, apparatus and installations for lighting, electrical control, heating and air-conditioning, signaling, monitoring, alarms, access control, home automation, building automation and industrial process controls</p>
--	---

Attachments	<p>77142654#TMSN.jpeg( bytes )</p> <p>77142698#TMSN.jpeg( bytes )</p> <p>79117560#TMSN.jpeg( bytes )</p> <p>F1433344.PDF(1148348 bytes )</p>
-------------	--

## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Robert Becker/
Name	ROBERT A BECKER
Date	04/16/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of the Application Serial No. 85/811,637  
Published in the Official Gazette of December 17, 2013

Mark: REXANT (Stylized)

REXEL DEVELOPPEMENT SAS,

Opposer,

v.

REXANT INTERNATIONAL LIMITED,

Applicant.

NOTICE OF OPPOSITION

Opposer, Rexel Developpement SAS, a French societe par actions simpliffee, with a place of business at 13 Boulevard du Fort de Vaux, 75017 Paris, France, believes that it will be damaged by registration of the mark REXANT (Stylized) shown in Application Serial No. 85/811,637, filed on December 28, 2012, and therefore opposes the same. As grounds for this opposition, Opposer, through its attorneys, alleges as follows:

1. Since before any priority date on which Applicant can rely and continuing through the present, Opposer has used the trademark REXEL in the United States in connection with wholesale, retail, and online retail store services relating to electric apparatuses.

2. Through promotional use for many years, Opposer's REXEL mark has become exclusively associated with Opposer and its services and represents substantial goodwill.

3. Opposer owns Reg. No. 3,656,343 for the mark REXEL for, *inter alia*, wholesale, retail, and online retail store services relating to electric apparatuses and instruments in Class 35. That registration issued on July 21, 2009 and is valid and subsisting.

4. Opposer owns Reg. No. 3,656,345 for the mark REXEL and Design for, *inter alia*, wholesale, retail, and online retail store services relating to electric apparatuses and instruments in Class 35. That registration issued on July 21, 2009 and is valid and subsisting.

5. Opposer owns Reg. No. 4,409,034 for the mark REXEL ENERGY IN MOTION (with ENERGY disclaimed) for, *inter alia*, wholesale and retail store services relating to electric apparatuses and instruments in Class 35. That registration issued on October 1, 2013 and is valid and subsisting. (The marks shown in Reg. Nos. 3,656,343, 3,656,345, and 4,409,034 shall be hereafter collectively referred to as “Opposer’s REXEL Marks.” TSDR printouts for the three registrations for Opposer’s REXEL Marks are attached.)

6. On December 28, 2012, Applicant filed application Serial No. 85/811,637 to register the trademark REXANT (Stylized) for the following goods, based on a Hong Kong registration filed on September 5, 2012:

“Hand-operated tools and implements, namely, cable and wire cutters, strippers, crimpers, terminators, connectors crimping tools, connector removal tools, jack termination tools, punch down and impact tools, cable tie guns, insertion and extraction tools, riveting hand tools, insulation displacement crimping hand tools, dies impact tools, screw fastening tools, beard clippers, electric hair clippers for personal use and for animals, non-electric hair clippers for personal use and for animals, shears, cattle shears; cutlery; razors” in Class 8;

“Measuring, signalling, checking apparatus and instruments, namely, ammeters, ohmmeters, voltmeters, frequency meters, multi-meters, AC volt detectors, moisture detectors, distance meters, stud detectors, metal detectors, batteries testers, network multi-modular cable testers, antennas, satellite finder, signal receivers, signal splitters; apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity, namely, electrical and electronic cables and wires,

copper and aluminum power cables, security cables, fire alarm cables, communications cables and wires, lan cables, coaxial cables, speaker cables, microphone cables, telephone cables, optical fiber cables, circuit closers, connectors for electricity, electric contacts, fuses, breakers, distribution boards, distribution boxes, distribution consoles, junction boxes, electricity conduits, sockets and plugs for electric connections, electric switches, switchboards, terminals for electricity, accumulators, batteries for electric, galvanic cells and batteries, chargers for electric batteries, battery boxes, solar batteries, circuit breakers, electric converters, switchboxes, transformers; apparatus for recording, transmission or reproduction of sound or images” in Class 9; and

“Plastics in extruded form for use in manufacture; packing and insulating materials; flexible pipes, not of metal” in Class 17.

7. On information and belief, Applicant did not use the subject mark prior to September 5, 2012.

8. Applicant’s mark is similar in appearance, sound and overall commercial impression to Opposer’s REXEL Marks.

9. Applicant seeks to register its mark for goods that are highly related to the services offered by Opposer under Opposer’s REXEL Marks and for which Opposer has registered Opposer’s REXEL Marks.

10. The use by Applicant of the REXANT mark, which is highly similar to Opposer’s REXEL Marks, on or in connection with goods highly related to the services offered by Opposer under Opposer’s REXEL Marks, is likely to cause confusion or to cause mistake, or to deceive the trade and public into believing that Applicant’s products offered under its mark come from the same source as services sold under Opposer’s REXEL Marks, or are otherwise authorized, sponsored, or licensed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

11. By reason of the foregoing, Opposer will be damaged by the registration of the mark shown in Application Serial No. 85/811,637.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that Application Serial No. 85/811,637 for registration of the mark REXANT (Stylized) be in all respects denied.

Dated: New York, New York  
April 16, 2014

Respectfully submitted,

FROSS ZELNICK LEHRMAN  
& ZISSU, P.C.

By: 

Craig S. Mende

Robert A. Becker

Attorneys for Opposer  
866 United Nations Plaza  
New York, New York 10017  
(212) 813-5900



CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the NOTICE OF OPPOSITION to be served by prepaid, first-class mail on this 16th day of April, 2014, upon applicant's attorney, Charles Ho, Esq., Barron & Young Intellectual Property Ltd., P.O. Box 1484, General Post Office, Hong Kong, Hong Kong.

  
Robert A. Becker

Generated on: This page was generated by TSDR on 2014-04-16 11:01:43 EDT

Mark: REXEL

REXEL

US Serial Number: 77142654      Application Filing Date: Mar. 28, 2007  
US Registration Number: 3656343      Registration Date: Jul. 21, 2009  
Register: Principal  
Mark Type: Trademark, Service Mark  
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.  
Status Date: Jul. 21, 2009  
Publication Date: May 05, 2009

## Mark Information

Mark Literal Elements: REXEL  
Standard Character Claim: Yes. The mark consists of standard characters without claim to any particular font style, size, or color.  
Mark Drawing Type: 4 - STANDARD CHARACTER MARK

## Related Properties Information

Claimed Ownership of US Registrations: 1942008

## Foreign Information

Priority Claimed: Yes  
Foreign Application Number: 063454033      Foreign Application Filing Date: Oct. 03, 2006  
Foreign Registration Number: 063454033      Foreign Registration Date: Oct. 03, 2006  
Foreign Application/Registration Country: FRANCE      Foreign Expiration Date: Oct. 03, 2016

## Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks "\*" identify additional (new) wording in the goods/services.

For: electric arc welding machines

International Class(es): 007 - Primary Class

U.S Class(es): 013, 019, 021, 023, 031, 034, 035

Class Status: ACTIVE

Basis: 44(e)

For: electric apparatuses and instruments, namely, apparatuses and instruments for conveying, distributing, transforming, storing, regulating or controlling electrical current; electrical couplings, accumulator jars; cases for accumulators; acidimeter for accumulators; chargers for electrical batteries; reels of electromagnets; electrical coils; holders for electrical coils; cathode ray tubes; photo voltaic cells; electronic components, namely, integrated circuits, semiconductors, diodes, for electronic installations, heat regulating device, namely, heat regulators; electric circuit breakers; flashing safety lights; bar code scanners; electrical commutators; electric installations, namely, wireless electronic and testing equipment for the remote control of industrial operations; electric devices and installations, namely, remote controllers for the remote control of electrical appliances, air conditioning and heating appliances, and lighting equipment; electric switches; electrical appliance for commutation, namely, electrical commutators, electrical supply sockets; electric terminals; distribution boxes for electricity; cable joint boxes for electricity; plug board boxes and electric plug boards; electrical cables for use in connections and electrical contacts; electrical contacts of precious metal; electrical connectors; electric connection boxes; electrical socket cover; electric control panels; power- lines transmission machines and apparatus; electric metering device, namely, electric meters and electric metering equipment, detectors, electric adapters, power adaptors for apparatus and goods for lighting, heating, air conditioning and air cooling and household electrical appliances and for apparatus and instruments for conducting, switching, connecting, transforming, accumulating, regulating, measuring or controlling electricity, namely, electric cables and electric ducts; electric transformers; electric circuit breakers, electric contractors and switches; electrical inductors; electrical armatures; electrical relays; rheostats; over-voltage protection controllers; electric choke coils; semi conductors; temperature regulators; current rectifiers, electronic pencils, devices, namely, distribution consoles for switching electricity for the distribution of electricity to be stored in desks; devices, namely, electricity distribution boxes for the distribution of electricity to be stored in cupboard; distribution boxes for electricity; fuses; lightning protectors, namely, lightning rods, electrical lightning conductors; antennas and electric or electronic

instruments of safety, namely, cameras, security panels, burglar alarms and security passive infra red and glass break sensors for movement or noise; sirens; electronic chimes for doors; electric buzzers; metal detectors for industrial or military purposes; smoke detectors; water level indicators; magnetic encoders; microphones; sound amplifiers; loudspeakers; cases for loudspeakers; audible warning devices, namely, acoustic alarms; warning signals, namely, anti-theft warning apparatus for sirens and audible warning devices connected to security systems; fire alarms; luminous beacons that act as lights; ballasts for lighting purposes; electronic luminous panels and mechanical signaling panels; luminous tubes for lighting for publicity; flash bulbs, flash lamps, optical lamps; thermionic lamps; fluorescent screens; optical lanterns for lightning purposes; electrical soldering iron; galvanic batteries; rechargeable electric batteries; batteries; battery for flashlights; power supplies; video and audio compact disc players; electric card readers and electronic locks with codes; electric devices for opening doors, namely, electric door openers, electric and electronic entrance intercoms; coin operated gates for car parks or parking lots; electrical or electronic appliances, namely, analog or digital voltage detectors and measurement devices for monitoring consumption of electric, domestic and industrial power instruments, namely, electric energy meters, electrical energy utilization metering devices, both remote and installed; electrical or electronic appliance for analysis of signals current and voltage, namely, test and measurement equipment, automation devices and remote monitoring equipment; devices, namely, apparatus for testing, measuring and capturing equipment, namely, metering equipment for testing measuring and capturing information on energy usage and quality; automation devices and remote monitoring equipment, namely, data recorders and data relays for electrical test and measurement equipment for counting, collecting, storing, converting, processing, entering, broadcasting, transmitting data, information and signals, namely, data processors and electronic relays for sensors; telebreakers; measuring devices and instruments, namely, handheld voltage current and wave form measurement devices, namely, handled voltage, current and wave form measurement equipment; volt meters; ammeters; frequency meters; temperature indicators; speed indicators; electricity conduits; high power electric cables; rigid electronic wire; conducting wire for luminous rays; flexible and extra flexible electric cable; insulated copper wire; coaxial cables; non-flammable electric cables; magnetic telephone wire, magnetic telephone safety wire and electric television cables; protected sheaths for electric cables; optical fiber cables, electrical and electronic devices for electrical and computer wiring, namely, category 5, Se, 6, 6e coaxial cables and their future enhancements, coaxial and other data transmission cable, and their associated insulation and termination products for electronic and IT wiring, namely, computer and data transmission and telephone cables; computer cables and electrical sockets for computer equipment; electrical and electronic appliances, namely, electrical outlet testers and continuity test apparatus for electrical circuits for testing IT and electric wiring; electric cable testers and electronic cable testers; electric convener; junction sleeves for electric cables; connections for electric lines; electrical identification wire for electric wires; magnetic wires; magnetic telephone wires; electric and optical connection wires; electronic indicator panels of electric loss; electronic indicator boards; antennas; anti-interference devices, namely, interferon meters and filters for radio interference suppression; control devices for elevators, namely, electric controller to manage power, movement and function of elevator; optical character readers, knee pads for work men, protective work gloves, protective gloves for industrial use, namely, protective gloves for protection against accidents; safety goggles, gas masks; protective eyepieces; protective helmets; shoes for protection against accidents, irradiation and fire

**International Class(es):** 009 - Primary Class

**U.S Class(es):** 021, 023, 026, 036, 038

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** electric lighting fixtures, namely, power failure back-ups safety lighting; lanterns, namely, electric lanterns; chandeliers; flashlights; lighting lamps; electric lights for Christmas trees and aquariums; floor lamps; laboratory lamps; safety lamps for underground use; filaments for electric lamps; electric heating filaments; arc lamps; lamp hanging supports; lamp reflectors, lamp shades; ceiling lights; luminous tubes for lighting; sockets for electric lights; electric flashlights for lighting; electric pocket search lights; lighting diffusers; tubes with electric discharges for lighting; sun lamps for cosmetic use; lighting bulbs; fluorescent lighting tubes, electric bulbs, devices and installations for drying, namely, electric hand drying apparatus for wash rooms; dryers, namely, electric hot air hand dryers; heating appliances, namely, heating furnaces; electric radiators, not for motors and engines; humidifiers for central heating radiators, radiators; hot water heaters; heat recovery machines; heat exchangers not being parts of machines; heaters for baths; hot plates; heating plates; solar collector; heat accumulators and heat regenerators; ionization devices for air treatment, namely, water ionizes for household purposes; air cleaning devices and machines, namely, air clearing units containing an air filter; air deodorization devices, namely, electric air deodorizers; air cooling devices, namely, evaporative air coolers, electric air conditioning fans; ventilating fans for commercial and industrial use, ventilation hoods; extractor hoods for kitchens; electric cooking stoves; freezers; ice making machines, refrigerators, cold combustion chambers, electric lanterns with signals; air conditioning units; lamps for projectors

**International Class(es):** 011 - Primary Class

**U.S Class(es):** 013, 021, 023, 031, 034

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** Wholesale store services, retail store services and online retail store services featuring devices and instruments for operation, distribution, connection, transformation, accumulation, adjustment, measurement, monitoring control of the electrical current, including cables and conduits; wholesale store services, retail store services and online retail store services featuring devices and products for lighting, heating, air conditioning, air cooling and household appliance; wholesale store services, retail store services and online retail store services featuring tools and instruments to cut, cut-out, bore, measure, tighten, crimp, unroll, strip and draw wires, sheaths and cables to weld, crimp file, build, actuated manually or electronically; wholesale store services, retail store services and online retail store services, featuring screws, bolts and products for mechanical or chemical fixing; wholesale store services, retail store services and online retail store services, featuring flexible pipes, insulator or insulating products and materials; wholesale store services and retail store services including by way of telecommunications and or data processing networks featuring devices and instrument for monitoring of safety of people, goods, site access; wholesale store services, retail store services and online retail store services featuring devices and insulations for home automation, building automation and industrial automatisms; wholesale store services, retail store services and online retail store services featuring IT equipment including data processing peripherals, connection cables and sockets for IT materials and installations; business organization and management consultancy; advertising servicing; conducting marketing studies; arranging and conducting trade show exhibitions in the field of electric and industrial equipment for commercial or publicity purposes, organizing profession markets, namely, job fairs for commercial or publicity purposes; purchasing agent services, namely, purchasing of products for others and business advice and analysis, namely, procurement and purchasing industrial equipment likely to meet the technical requirements defined in technical specification

**International Class(es):** 035 - Primary Class

**U.S Class(es):** 100, 101, 102

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** corporate financing services; investment services, namely, management of portfolios of financial interest; asset and real estate management

**International Class(es):** 036 - Primary Class

**U.S Class(es):** 100, 101, 102

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** installation, maintenance and repair of electric devices and installation, electronic motors, panel boards and PLC's and the associated programming of the se products; installation, maintenance and repair of devices and products, namely, electric motors, panel boards, PLL's and the associated programming of these products for lightning, heating, air conditioning cooling of air and household appliances; installation, maintenance and repair of alarm access control and monitoring devices installations for home, automation, building automation, and industrial automatism; rental of hand and power tools, electric and band operated, namely, tools and instruments for cutting, cropping, drilling, measuring, tightening, crimping, uncoiling, stripping and pulling wires, sheaths and cables for welding filling and brick laying; rental of apparatus and instruments, namely, hand and power tools for conducting, transforming, accumulating, regulating or controlling electricity

**International Class(es):** 037 - Primary Class

**U.S Class(es):** 100, 103, 106

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** Rental of devices and instruments for the distribution of electricity

**International Class(es):** 039 - Primary Class

**U.S Class(es):** 100, 105

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** Technical advice, technical consultation and technical research in the field of the design and development of material and installations for operation, distribution, transformation, accumulation, adjustment, measurement, control or the ordering of the electrical current; technical advice and technical consultation and technical research in the field the design and development of devices, material and installations for lighting, ventilation, heating or cooling of air; advice, consultation and technical research in the field the design and development of home automation, building automation and industrial automatisms; technical advice, technical consultation and technical research in the field of the design and development of devices for safety and distance monitoring of persons and goods, industrial facilities or service activities and private residences; technical research in the field of technology with respect to need assessment in terms of electric material and installation, including cables, in terms of air heating and cooling, house automation, building automation, industrial automatisms, safety and monitoring; technical consultation and research in the field of testing of new products for others, as it relates to technical performance evaluation, compatibility analysis and the possibilities of integration of electric materials in complex electric installations; technical analysis of products for others to determine how to make them more environmentally sound and consulting services in the field of the selection of electrical and industrial equipment, namely, computer hardware and software systems, likely to meet the technical requirements defined in a technical specification; providing technological information in the field of electric materials, devices, and installations, electrically operated materials and devices, electric monitoring systems, home automation systems, alarm monitoring systems, electronic access control systems, electronic building information systems, and electronic industrial automation systems; providing technological information in the field of electric materials, devices, and installations, electrically operated materials and devices, electric monitoring systems, home automation systems, alarm monitoring systems, electronic access control systems, electronic building information systems, and electronic industrial automation systems via the Internet; providing technological information in the field of devices and installations for lighting electronic operation, heating and air conditioning and lighting for street signs; providing technological information in the field of devices and installations for lighting electronic operation, heating and air conditioning and lighting for street signs via the Internet

**International Class(es):** 042 - Primary Class

**U.S Class(es):** 100, 101

**Class Status:** ACTIVE

**Basis:** 44(e)

## Basis Information (Case Level)

**Filed Use:** No

**Currently Use:** No

**Amended Use:** No

**Filed ITU:** No

**Currently ITU:** No

**Amended ITU:** No

**Filed 44D:** Yes

**Currently 44D:** No

**Amended 44D:** No

**Filed 44E:** No

**Currently 44E:** Yes

**Amended 44E:** No

**Filed 66A:** No

**Currently 66A:** No

**Filed No Basis:** No

**Currently No Basis:** No

## Current Owner(s) Information

**Owner Name:** REXEL DEVELOPPEMENT SAS

**Owner Address:** 189-193 BOULEVARD MALESHERBES  
75017 PARIS  
FRANCE

**Legal Entity Type:** SOCIETE PAR ACTIONS SIMPLIFIEE

**State or Country Where** FRANCE

**Organized:**

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Lawrence E. Apolzon

**Docket Number:** REXE 0702692

### Correspondent

**Correspondent Name/Address:** LAWRENCE E. APOLZON  
FROSS ZELNICK LEHRMAN & ZISSU, P.C.  
866 UNITED NATIONS PLAZA  
NEW YORK, NEW YORK 10017-1822  
UNITED STATES

Phone: 212-813-5900

Fax: 212-813-5901

**Domestic Representative**

**Domestic Representative** Fross Zelnick Lehrman & Zissu, P.C.  
**Name:**

**Phone:** 212-813-5900

**Fax:** 212-813-5901

---

**Prosecution History**

---

<b>Date</b>	<b>Description</b>	<b>Proceeding Number</b>
Mar. 21, 2012	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jul. 21, 2009	REGISTERED-PRINCIPAL REGISTER	
May 05, 2009	PUBLISHED FOR OPPOSITION	
Apr. 15, 2009	NOTICE OF PUBLICATION	
Apr. 02, 2009	LAW OFFICE PUBLICATION REVIEW COMPLETED	66213
Apr. 01, 2009	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 11, 2009	EXAMINERS AMENDMENT MAILED	
Mar. 10, 2009	EXAMINER'S AMENDMENT ENTERED	88888
Mar. 10, 2009	EXAMINERS AMENDMENT -WRITTEN	82438
Mar. 06, 2009	NON-FINAL ACTION MAILED	
Mar. 05, 2009	NON-FINAL ACTION WRITTEN	82438
Feb. 25, 2009	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
Feb. 13, 2009	WITHDRAWN FROM PUB - OG REVIEW QUERY	61844
Feb. 04, 2009	LAW OFFICE PUBLICATION REVIEW COMPLETED	66213
Feb. 04, 2009	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jan. 26, 2009	EXAMINERS AMENDMENT MAILED	
Jan. 23, 2009	EXAMINER'S AMENDMENT ENTERED	88888
Jan. 23, 2009	EXAMINERS AMENDMENT -WRITTEN	82438
Dec. 02, 2008	NON-FINAL ACTION MAILED	
Dec. 01, 2008	NON-FINAL ACTION WRITTEN	82438
Nov. 07, 2008	EXAMINERS AMENDMENT MAILED	
Nov. 06, 2008	EXAMINER'S AMENDMENT ENTERED	88888
Nov. 06, 2008	EXAMINERS AMENDMENT -WRITTEN	82438
Sep. 23, 2008	ACTION DENYING REQ FOR RECON MAILED	
Sep. 23, 2008	ACTION CONTINUING FINAL - COMPLETED	82438
Sep. 05, 2008	AMENDMENT FROM APPLICANT ENTERED	66213
Sep. 05, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	66213
Sep. 03, 2008	ASSIGNED TO LIE	66213
Aug. 25, 2008	PAPER RECEIVED	
Feb. 27, 2008	FINAL REFUSAL MAILED	
Feb. 26, 2008	FINAL REFUSAL WRITTEN	82438
Jan. 31, 2008	AMENDMENT FROM APPLICANT ENTERED	77312
Jan. 31, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	77312
Jan. 29, 2008	ASSIGNED TO LIE	77312
Jan. 28, 2008	PAPER RECEIVED	
Jul. 25, 2007	NON-FINAL ACTION MAILED	
Jul. 25, 2007	NON-FINAL ACTION WRITTEN	82438
Jul. 10, 2007	ASSIGNED TO EXAMINER	82438
Apr. 19, 2007	APPLICANT AMENDMENT PRIOR TO EXAMINATION - ENTERED	77978
May 11, 2007	APPLICANT AMENDMENT PRIOR TO EXAMINATION - ENTERED	77978
May 11, 2007	ASSIGNED TO LIE	77978

Apr. 19, 2007 PAPER RECEIVED  
Apr. 04, 2007 PAPER RECEIVED  
Apr. 02, 2007 NEW APPLICATION ENTERED IN TRAM

## TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jul. 21, 2009

## Assignment Abstract Of Title Information

### Summary

Total Assignments: 1

Registrant: Rexel Distribution

### Assignment 1 of 1

Conveyance: MERGER EFFECTIVE 07/26/2011

Reel/Frame: 4737/0809

Pages: 6

Date Recorded: Mar. 16, 2012

Supporting Documents: assignment-tm-4737-0809.pdf

### Assignor

Name: REXEL DISTRIBUTION

Execution Date: Jun. 21, 2011

Legal Entity Type: CORPORATION

State or Country Where  
Organized: FRANCE

### Assignee

Name: REXEL DEVELOPPEMENT SAS

Legal Entity Type: SOCIETE PAR ACTIONS SIMPLIFIEE

State or Country Where  
Organized: FRANCE

Address: 189-193 BOULEVARD MALESHERBES  
75017 PARIS, FRANCE

### Correspondent

Correspondent Name: ROBERT A. BECKER

Correspondent Address: FROSS ZELNICK LEHRMAN & ZISSU, P.C.  
866 UNITED NATIONS PLAZA  
NEW YORK, NY 10017

Domestic Representative - Not Found

## Proceedings

### Summary

Number of Proceedings: 1

### Type of Proceeding: Opposition

Proceeding Number: 91209858

Filing Date: Mar 20, 2013

Status: Terminated

Status Date: Jul 12, 2013

Interlocutory Attorney: BENJAMIN U OKEKE

### Defendant

Name: Advanced Industries & Technologies, LLC

Correspondent Address: STEPHANIE POTTICK  
POTTICK LAW  
PO BOX 405  
HUNTINGTON BEACH CA , 92648-0405  
UNITED STATES

Correspondent e-mail: potticklaw@earthlink.net

### Associated marks

Mark

Application Status

Serial  
Number

Registration  
Number

REXDEL

Abandoned - After Inter-Partes Decision

85505293

Plaintiff(s)

Name: Rexel Developpement SAS

Correspondent Address: ROBERT A BECKER  
FROSS ZELNICK LEHRMAN & ZISSU PC  
866 UNITED NATIONS PLAZA  
NEW YORK NY , 10017  
UNITED STATES

Correspondent e-mail: [rbecker@frosszelnick.com](mailto:rbecker@frosszelnick.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
REXEL	Registered	<u>77142654</u>	<u>3656343</u>
REXEL	Registered	<u>77142698</u>	<u>3656345</u>
REXEL	Registered	<u>77142880</u>	<u>3656346</u>

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Mar 20, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Mar 20, 2013	Apr 29, 2013
3	PENDING, INSTITUTED	Mar 20, 2013	
4	NOTICE OF DEFAULT	May 20, 2013	
5	BD DECISION: SUSTAINED	Jul 12, 2013	
6	TERMINATED	Jul 12, 2013	

Generated on: This page was generated by TSDR on 2014-04-16 11:02:17 EDT

Mark: REXEL



US Serial Number: 77142698  
US Registration Number: 3656345  
Register: Principal  
Mark Type: Trademark, Service Mark  
Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.  
Status Date: Jul, 21, 2009  
Publication Date: May 05, 2009

Application Filing Date: Mar, 28, 2007

Registration Date: Jul, 21, 2009

## Mark Information

Mark Literal Elements: REXEL  
Standard Character Claim: No  
Mark Drawing Type: 3 - AN ILLUSTRATION DRAWING WHICH INCLUDES WORD(S)/ LETTER(S)/NUMBER(S)  
Description of Mark: The mark consists of the word "REXEL" which is stylized in white sitting in a blue rectangle, which has a rounded upper right corner. There is a thin white line segment there below that separates a smaller orange rectangle with a rounded lower left corner beneath that.  
Color Drawing: Yes  
Color(s) Claimed: The color(s) blue, white, and orange is/are claimed as a feature of the mark.  
Design Search Code(s): 26.11.02 - Plain single line rectangles; Rectangles (single line)  
26.11.10 - Rectangles divided once into two sections  
26.11.21 - Rectangles that are completely or partially shaded

## Related Properties Information

Claimed Ownership of US Registrations: 1942008

## Foreign Information

Priority Claimed: Yes  
Foreign Application Number: 063454032  
Foreign Registration Number: 063454032  
Foreign Application/Registration Country: FRANCE  
Foreign Application Filing Date: Oct, 03, 2006  
Foreign Registration Date: Oct, 03, 2006  
Foreign Expiration Date: Oct, 03, 2016

## Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks \*..\* identify additional (new) wording in the goods/services.

For: Electric arc welding machines

International Class(es): 007 - Primary Class

U.S Class(es): 013, 019, 021, 023, 031, 034, 035

Class Status: ACTIVE

Basis: 44(e)

For: electric apparatuses and instruments, namely, apparatuses and instruments for conveying, distributing, transforming, storing, regulating or controlling electrical current; electrical couplings, accumulator jars; cases for accumulators; acidimeter for accumulators; chargers for electrical batteries; reels of electromagnets; electrical coils; holders for electrical coils; cathode ray tubes; photo voltaic cells; electronic components, namely, integrated circuits, semiconductors, diodes, for electronic installations, heat regulating device, namely, heat regulators; electric circuit breakers; flashing safety lights; bar code scanners; electrical commutators; electric installations, namely, wireless electronic and testing equipment for the remote control of industrial operations; electric devices and installations, namely, remote controllers for the remote control of electrical appliances, air conditioning and heating appliances, and lighting equipment; electric switches; electrical appliance for commutation, namely, electrical commutators, electrical supply sockets; electric terminals; distribution boxes for electricity; cable joint boxes for electricity; plug board boxes and electric plug boards; electrical cables for use in connections and electrical contacts; electrical contacts of precious metal; electrical connectors; electric connection boxes;



electrical socket cover; electric control panels; power- lines transmission machines and apparatus; electric metering device, namely, electric meters and electric metering equipment, detectors, electric adapters, power adaptors for apparatus and goods for lighting, heating, air conditioning and air cooling and household electrical appliances and for apparatus and instruments for conducting, switching, connecting, transforming, accumulating, regulating, measuring or controlling electricity, namely, electric cables and electric ducts; electric transformers; electric circuit breakers, electric contractors and switches; electrical inductors; electrical armatures; electrical relays; rheostats; over-voltage protection controllers; electric choke coils; semi conductors; temperature regulators; current rectifiers, electronic pencils, devices, namely, distribution consoles for switching electricity for the distribution of electricity to be stored in desks; devices, namely, electricity distribution boxes for the distribution of electricity to be stored in cupboard; distribution boxes for electricity; fuses; lightning protectors, namely, lightning rods, electrical lightning conductors; antennas and electric or electronic instruments of safety, namely, cameras, security panels, burglar alarms and security passive infra red and glass break sensors for movement or noise; sirens; electronic chimes for doors; electric buzzers; metal detectors for industrial or military purposes; smoke detectors; water level indicators; magnetic encoders; microphones; sound amplifiers; loudspeakers; cases for loudspeakers; audible warning devices, namely, acoustic alarms; warning signals, namely, anti-theft warning apparatus for sirens and audible warning devices connected to security systems; fire alarms; luminous beacons that act as lights; ballasts for lighting purposes; electronic luminous panels and mechanical signaling panels; luminous tubes for lighting for publicity; flash bulbs, flash lamps; optical lamps; thermionic lamps; fluorescent screens; optical lanterns for lightning purposes; electrical soldering iron; galvanic batteries; rechargeable electric batteries; batteries; battery for flashlights; power supplies; video and audio compact disc players; electric card readers and electronic locks with codes; electric devices for opening doors, namely, electric door openers, electric and electronic entrance intercoms; coin operated gates for car parks or parking lots; electrical or electronic appliances, namely, analog or digital voltage detectors and measurement devices for monitoring consumption of electric, domestic and industrial power instruments, namely, electric energy meters, electrical energy utilization metering devices, both remote and installed; electrical or electronic appliance for analysis of signals current and voltage, namely, test and measurement equipment, automation devices and remote monitoring equipment; devices, namely, apparatus for testing, measuring and capturing equipment, namely, metering equipment for testing measuring and capturing information on energy usage and quality; automation devices and remote monitoring equipment, namely, data recorders and data relays for electrical test and measurement equipment for counting, collecting, storing, converting, processing, entering, broadcasting, transmitting data, information and signals, namely, data processors and electronic relays for sensors; telebreakers; measuring devices and instruments, namely, handheld voltage current and wave form measurement devices, namely, handled voltage, current and wave form measurement equipment; volt meters; ammeters; frequency meters; temperature indicators; speed indicators; electricity conduits; high power electric cables; rigid electronic wire; conducting wire for luminous rays; flexible and extra flexible electric cable; insulated copper wire; coaxial cables; non-flammable electric cables; magnetic telephone wire, magnetic telephone safety wire and electric television cables; protected sheaths for electric cables; optical fiber cables, electrical and electronic devices for electrical and computer wiring, namely, category 5, Se, 6, 6e coaxial cables and their future enhancements, coaxial and other data transmission cable, and their associated insulation and termination products for electronic and IT wiring, namely, computer and data transmission and telephone cables; computer cables and electrical sockets for computer equipment; electrical and electronic appliances, namely, electrical outlet testers and continuity test apparatus for electrical circuits for testing IT and electric wiring; electric cable testers and electronic cable testers; electric convener; junction sleeves for electric cables; connections for electric lines; electrical identification wire for electric wires; magnetic wires; magnetic telephone wires; electric and optical connection wires; electronic indicator panels of electric loss; electronic indicator boards; antennas; anti-interference devices, namely, interferon meters and filters for radio interference suppression; control devices for elevators, namely, electric controller to manage power, movement and function of elevator; optical character readers, knee pads for work men, protective work gloves, protective gloves for industrial use, namely, protective gloves for protection against accidents; safety goggles, gas masks; protective eyepieces; protective helmets; shoes for protection against accidents, irradiation and fire

**International Class(es):** 009 - Primary Class

**U.S Class(es):** 021, 023, 026, 036, 038

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** electric lighting fixtures, namely, power failure back-ups safety lighting; lanterns, namely, electric lanterns; chandeliers; flashlights; lighting lamps; electric lights for Christmas trees and aquariums; floor lamps; laboratory lamps; safety lamps for underground use; filaments for electric lamps; electric heating filaments; arc lamps; lamp hanging supports; lamp reflectors, lamp shades; ceiling lights; luminous tubes for lighting; sockets for electric lights; electric flashlights for lighting; electric pocket search lights; lighting diffusers; tubes with electric discharges for lighting; sun lamps for cosmetic use; lighting bulbs; fluorescent lighting tubes, electric bulbs, devices and installations for drying, namely, electric hand drying apparatus for washrooms; dryers, namely, electric hot air hand dryers; heating appliances, namely, heating furnaces; electric radiators, not for motors and engines; humidifiers for central heating radiators, radiators; hot water heaters; heat recovery machines; heat exchangers not being parts of machines; heaters for baths; hot plates; heating plates; solar collector; heat accumulators and heat regenerators; ionization devices for air treatment, namely, water ionizes for household purposes; air cleaning devices and machines, namely, air clearing units containing an air filter; air deodorization devices, namely, electric air deodorizers; air cooling devices, namely, evaporative air coolers, electric air conditioning fans; ventilating fans for commercial and industrial use, ventilation hoods; extractor hoods for kitchens; electric cooking stoves; freezers; ice making machines, refrigerators, cold combustion chambers, electric lanterns with signals; air conditioning units; lamps for projectors

**International Class(es):** 011 - Primary Class

**U.S Class(es):** 013, 021, 023, 031, 034

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** Wholesale store services, retail store services and online retail store services featuring devices and instruments for operation, distribution, connection, transformation, accumulation, adjustment, measurement, monitoring control of the electrical current, including cables and conduits; wholesale store services, retail store services and online retail store services featuring devices and products for lighting, heating, air conditioning, air cooling and household appliance; wholesale store services, retail store services and online retail store services featuring tools and instruments to cut, cut-out, bore, measure, tighten, crimp, unroll, strip and draw wires, sheaths and cables to weld, crimp file, build, actuated manually or electronically; wholesale store services, retail store services and online retail store services, featuring screws, bolts and products for mechanical or chemical fixing; wholesale store services, retail store services and online retail store services, featuring flexible pipes, insulator or insulating products and materials; wholesale store services and retail store services including by way of telecommunications and or data processing networks featuring devices and instrument for monitoring of safety of people, goods, site access; wholesale store services, retail store services and online retail store services featuring devices and insulations for home automation, building automation and industrial automatisms; wholesale store services, retail store services and online retail store services featuring IT equipment including data processing peripherals, connection cables and sockets for IT materials and installations; business organization and management consultancy; advertising servicing; conducting marketing studies; arranging and conducting trade show exhibitions in the field of electric and industrial equipment for commercial or publicity purposes, organizing profession markets, namely, job fairs for commercial or publicity purposes; purchasing agent services, namely, purchasing of products for others and business advice and analysis, namely, procurement and purchasing industrial equipment likely to meet the technical requirements defined in technical specification

**International Class(es):** 035 - Primary Class

**U.S Class(es):** 100, 101, 102

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** corporate financing services; investment services, namely, management of portfolios of financial interest; asset and real estate management

**International Class(es):** 036 - Primary Class

**U.S Class(es):** 100, 101, 102

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** Installation, maintenance and repair of electric devices and installation, electronic motors, panel boards and PLC's and the associated programming of these products; installation, maintenance and repair of devices and products, namely, electric motors, panel boards, PLL's and the associated programming of these products for lightning, heating, air conditioning cooling of air and household appliances; installation, maintenance and repair of alarm access control and monitoring devices installations for home, automation, building automation, and industrial automatism; rental of hand and power tools, electric and hand operated, namely, tools and instruments for cuffing, cropping, drilling, measuring, tightening, crimping, uncoiling, stripping and pulling wires, sheaths and cables for welding filling and brick laying; rental of apparatus and instruments, namely, hand and power tools for conducting, transforming, accumulating, regulating or controlling electricity

**International Class(es):** 037 - Primary Class

**U.S Class(es):** 100, 103, 106

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** Rental of devices and instruments for the distribution of electricity

**International Class(es):** 039 - Primary Class

**U.S Class(es):** 100, 105

**Class Status:** ACTIVE

**Basis:** 44(e)

**For:** Technical advice, technical consultation and technical research in the field of the design and development of material and installations for operation, distribution, transformation, accumulation, adjustment, measurement, control or the ordering of the electrical current; technical advice and technical consultation and technical research in the field the design and development of devices, material and installations for lighting, ventilation, heating or cooling of air; advice, consultation and technical research in the field the design and development of home automation, building automation and industrial automatisms; technical advice, technical consultation and technical research in the field of the design and development of devices for safety and distance monitoring of persons and goods, industrial facilities or service activities and private residences; technical research in the field of technology with respect to need assessment in terms of electric material and installation, including cables, in terms of air heating and cooling, house automation, building automation, industrial automatisms, safety and monitoring; technical consultation and research in the field of testing of new products for others, as it relates to technical performance evaluation, compatibility analysis and the possibilities of integration of electric materials in complex electric installations; technical analysis of products for others to determine how to make them more environmentally sound and consulting services in the field of the selection of electrical and industrial equipment, namely, computer hardware and software systems, likely to meet the technical requirements defined in a technical specification; providing technological information in the field of electric materials, devices, and installations, electrically operated materials and devices, electric monitoring systems, home automation systems, alarm monitoring systems, electronic access control systems, electronic building information systems, and electronic industrial automation systems; providing technological information in the field of electric materials, devices, and installations, electrically operated materials and devices, electric monitoring systems, home automation systems, alarm monitoring systems, electronic access control systems, electronic building information systems, and electronic industrial automation systems via the Internet; providing technological information in the field of devices and installations for lighting electronic operation, heating and air conditioning and lighting for street signs; providing technological information in the field of devices and installations for lighting electronic operation, heating and air conditioning and lighting for street signs via the Internet

**International Class(es):** 042 - Primary Class

**U.S Class(es):** 100, 101

**Class Status:** ACTIVE

**Basis:** 44(e)

## Basis Information (Case Level)

<b>Filed Use:</b> No	<b>Currently Use:</b> No	<b>Amended Use:</b> No
<b>Filed ITU:</b> No	<b>Currently ITU:</b> No	<b>Amended ITU:</b> No
<b>Filed 44D:</b> Yes	<b>Currently 44D:</b> No	<b>Amended 44D:</b> No
<b>Filed 44E:</b> No	<b>Currently 44E:</b> Yes	<b>Amended 44E:</b> No
<b>Filed 66A:</b> No	<b>Currently 66A:</b> No	
<b>Filed No Basis:</b> No	<b>Currently No Basis:</b> No	

## Current Owner(s) Information

**Owner Name:** REXEL DEVELOPPEMENT SAS

**Owner Address:** 189-193 BOULEVARD MALESHERBES  
75017 PARIS  
FRANCE

**Legal Entity Type:** SOCIETE PAR ACTIONS SIMPLIFIEE

**State or Country Where Organized:** FRANCE

## Attorney/Correspondence Information

**Attorney of Record**

**Attorney Name:** Lawrence E. Apolzon

**Docket Number:** REXE 0702694

**Correspondent**

**Correspondent** LAWRENCE E. APOLZON  
**Name/Address:** FROSS ZELNICK LEHRMAN & ZISSU, P.C.  
866 UNITED NATIONS PLAZA  
NEW YORK, NEW YORK 10017-1822  
UNITED STATES

**Phone:** 212-813-5900

**Fax:** 212-813-5901

**Domestic Representative**

**Domestic Representative** Fross Zelnick Lehrman & Zissu, P.C.  
**Name:**

**Phone:** 212-813-5900

**Fax:** 212-813-5901

---

## Prosecution History

---

Date	Description	Proceeding Number
Mar. 21, 2012	AUTOMATIC UPDATE OF ASSIGNMENT OF OWNERSHIP	
Jul. 21, 2009	REGISTERED-PRINCIPAL REGISTER	
May 05, 2009	PUBLISHED FOR OPPOSITION	
Apr. 15, 2009	NOTICE OF PUBLICATION	
Apr. 02, 2009	LAW OFFICE PUBLICATION REVIEW COMPLETED	66213
Apr. 01, 2009	APPROVED FOR PUB - PRINCIPAL REGISTER	
Mar. 11, 2009	EXAMINERS AMENDMENT MAILED	
Mar. 10, 2009	EXAMINER'S AMENDMENT ENTERED	88888
Mar. 10, 2009	EXAMINERS AMENDMENT -WRITTEN	82438
Mar. 06, 2009	NON-FINAL ACTION MAILED	
Mar. 05, 2009	NON-FINAL ACTION WRITTEN	82438
Mar. 04, 2009	PREVIOUS ALLOWANCE COUNT WITHDRAWN	
Feb. 27, 2009	WITHDRAWN FROM PUB - OG REVIEW QUERY	61844
Feb. 13, 2009	LAW OFFICE PUBLICATION REVIEW COMPLETED	66213
Feb. 13, 2009	EXAMINERS AMENDMENT MAILED	
Feb. 12, 2009	APPROVED FOR PUB - PRINCIPAL REGISTER	
Feb. 12, 2009	EXAMINER'S AMENDMENT ENTERED	88888
Feb. 12, 2009	EXAMINERS AMENDMENT -WRITTEN	82438
Jan. 26, 2009	EXAMINERS AMENDMENT MAILED	
Jan. 23, 2009	EXAMINER'S AMENDMENT ENTERED	88888
Jan. 23, 2009	EXAMINERS AMENDMENT -WRITTEN	82438
Dec. 02, 2008	NON-FINAL ACTION MAILED	
Dec. 01, 2008	NON-FINAL ACTION WRITTEN	82438
Nov. 07, 2008	EXAMINER'S AMENDMENT ENTERED	66213
Nov. 07, 2008	EXAMINERS AMENDMENT MAILED	
Nov. 06, 2008	EXAMINERS AMENDMENT -WRITTEN	82438
Sep. 23, 2008	ACTION DENYING REQ FOR RECON MAILED	
Sep. 23, 2008	ACTION CONTINUING FINAL - COMPLETED	82438
Sep. 09, 2008	AMENDMENT FROM APPLICANT ENTERED	66213
Sep. 09, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	66213
Sep. 03, 2008	ASSIGNED TO LIE	66213
Aug. 25, 2008	PAPER RECEIVED	
Feb. 27, 2008	FINAL REFUSAL MAILED	
Feb. 26, 2008	FINAL REFUSAL WRITTEN	82438
Jan. 31, 2008	AMENDMENT FROM APPLICANT ENTERED	77312
Jan. 31, 2008	CORRESPONDENCE RECEIVED IN LAW OFFICE	77312

Jan. 29, 2008	ASSIGNED TO LIE	77312
Jan. 28, 2008	PAPER RECEIVED	
Jul. 26, 2007	NON-FINAL ACTION MAILED	
Jul. 25, 2007	NON-FINAL ACTION WRITTEN	82438
Jul. 10, 2007	ASSIGNED TO EXAMINER	82438
Apr. 19, 2007	APPLICANT AMENDMENT PRIOR TO EXAMINATION - ENTERED	77978
May 15, 2007	APPLICANT AMENDMENT PRIOR TO EXAMINATION - ENTERED	77978
May 11, 2007	ASSIGNED TO LIE	77978
Apr. 19, 2007	PAPER RECEIVED	
Apr. 04, 2007	PAPER RECEIVED	
Apr. 03, 2007	NOTICE OF DESIGN SEARCH CODE MAILED	
Apr. 02, 2007	NEW APPLICATION ENTERED IN TRAM	

---

### TM Staff and Location Information

---

TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Jul. 21, 2009

---

### Assignment Abstract Of Title Information

---

#### Summary

Total Assignments: 1

Registrant: Rexel Distribution

---

#### Assignment 1 of 1

---

Conveyance: MERGER EFFECTIVE 07/26/2011

Reel/Frame: [4737/0809](#)

Pages: 6

Date Recorded: Mar. 16, 2012

Supporting Documents: [assignment-tm-4737-0809.pdf](#)

#### Assignor

Name: [REXEL DISTRIBUTION](#)

Execution Date: Jun. 21, 2011

Legal Entity Type: CORPORATION

State or Country Where  
Organized: FRANCE

#### Assignee

Name: [REXEL DEVELOPPEMENT SAS](#)

Legal Entity Type: SOCIETE PAR ACTIONS SIMPLIFIEE

State or Country Where  
Organized: FRANCE

Address: 189-193 BOULEVARD MALESHERBES  
75017 PARIS, FRANCE

#### Correspondent

Correspondent Name: ROBERT A. BECKER

Correspondent Address: FROSS ZELNICK LEHRMAN & ZISSU, P.C.  
866 UNITED NATIONS PLAZA  
NEW YORK, NY 10017

Domestic Representative - Not Found

---

### Proceedings

---

#### Summary

Number of Proceedings: 1

---

#### Type of Proceeding: Opposition

---

Proceeding Number: [91209858](#)

Filing Date: Mar 20, 2013

Status: Terminated

Status Date: Jul 12, 2013

Interlocutory Attorney: BENJAMIN U OKEKE

#### Defendant

Name: Advanced Industries & Technologies, LLC

Correspondent Address: STEPHANIE POTTICK  
POTTICK LAW  
PO BOX 405  
HUNTINGTON BEACH CA , 92648-0405  
UNITED STATES

Correspondent e-mail: [potticklaw@earthlink.net](mailto:potticklaw@earthlink.net)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
REXDEL	Abandoned - After Inter-Partes Decision Plaintiff(s)	<a href="#">85505293</a>	

Name: Rexel Developpement SAS

Correspondent Address: ROBERT A BECKER  
FROSS ZELNICK LEHRMAN & ZISSU PC  
866 UNITED NATIONS PLAZA  
NEW YORK NY , 10017  
UNITED STATES

Correspondent e-mail: [rbecker@frosszelnick.com](mailto:rbecker@frosszelnick.com)

**Associated marks**

Mark	Application Status	Serial Number	Registration Number
REXEL	Registered	<a href="#">77142654</a>	<a href="#">3656343</a>
REXEL	Registered	<a href="#">77142698</a>	<a href="#">3656345</a>
REXEL	Registered	<a href="#">77142880</a>	<a href="#">3656346</a>

**Prosecution History**

Entry Number	History Text	Date	Due Date
1	FILED AND FEE	Mar 20, 2013	
2	NOTICE AND TRIAL DATES SENT; ANSWER DUE:	Mar 20, 2013	Apr 29, 2013
3	PENDING, INSTITUTED	Mar 20, 2013	
4	NOTICE OF DEFAULT	May 20, 2013	
5	BD DECISION: SUSTAINED	Jul 12, 2013	
6	TERMINATED	Jul 12, 2013	

Generated on: This page was generated by TSDR on 2014-04-16 11:02:39 EDT

Mark: REXEL ENERGY IN MOTION

Rexel Energy in motion

US Serial Number: 79117560

Application Filing Date: Jul. 11, 2012

US Registration Number: 4409034

Registration Date: Oct. 01, 2013

Register: Principal

Mark Type: Service Mark

Status: Registered. The registration date is used to determine when post-registration maintenance documents are due.

Status Date: Oct. 01, 2013

Publication Date: Jul. 16, 2013

## Mark Information

Mark Literal Elements: REXEL ENERGY IN MOTION

Standard Character Claim: No

Mark Drawing Type: 5 - AN ILLUSTRATION DRAWING WITH WORD(S) /LETTER(S)/ NUMBER(S) INSTYLIZED FORM

Color(s) Claimed: Color is not claimed as a feature of the mark.

Disclaimer: "ENERGY"

## Related Properties Information

International Registration Number: 1128368

International Registration Date: Jul. 11, 2012

Claimed Ownership of US Registrations: 3656344, 3656345, 3656346

## Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks \*,\* identify additional (new) wording in the goods/services.

**For:** Wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring apparatus and instruments for conducting, switching, connecting, transforming, accumulating, regulating, measuring, checking or controlling electricity, including electrical conduits and cables; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring apparatus and goods for lighting, heating, air conditioning, air cooling and for electric household appliances; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring tools and instruments for cutting, chopping, drilling, measuring, clamping, unwinding, stripping and drawing wires, sheaths and cables for soldering, crimping, filing and for laying bricks, manually or electrically operated; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring fastening and bolting products and for mechanical or chemical affixing products; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring goods for dusting, cleaning, wiping, galvanizing, lubricating, unjamming, greasing, varnishing, dehumidifying and protecting against humidity and local cooling; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring flexible tubes, insulating goods and materials; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring apparatus and instruments for surveillance and security of persons, property, access points and sites; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring apparatus and installations for home automation, building automation and industrial process controls; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring apparatus for recording, transmitting, reproducing sound, images or data including apparatus and instruments for communication; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring computer hardware including computer peripheral devices, cables and connector plugs for computer hardware and installations; wholesale and retail store services, including by means of telecommunication and/or computer networks, featuring downloadable electronic publications; business management and organization consultancy; business administration; consultancy relating to commercial strategy and consulting relating to commercial management and development; professional business consultancy and providing business information; conducting marketing studies; organization of trade shows, exhibitions, trade fairs and job fairs for commercial or advertising purposes; business and marketing commercial analysis in the nature of shortlisting of products for others and commercial consultancy in the field of electrical and industrial equipment likely to meet technical requirements defined in a technical project specification; dissemination of advertisements; direct mail advertising services; organization of promotional and advertising activities for developing customer loyalty; business efficiency expert services; commercial or industrial business management assistance; data processing services, namely, administrative processing of purchase orders; commercial information and advice for consumers; computerized file management; collection and systemization of data into computer databases; compilation of statistics; promoting the goods and services of others by means of the issuance of loyalty cards for commercial purposes enabling the acquisition of discount vouchers

International Class(es): 035 - Primary Class

U.S Class(es): 100, 101, 102

Class Status: ACTIVE

Basis: 66(a)

**For:** Financial affairs, namely, credit and financial consultation, financial forecasting, financial planning, monetary affairs, namely, acquisition and transfer of monetary claims, money order services, and real estate affairs, namely, real estate escrow services, real estate listing, real estate investment; providing financial information, investigations, forecasts and expert appraisals on real estate and personal property of others; capital investment services, namely, capital raising, investment and placement; venture capital advisory services and fund management and financing services; corporate financing services; financial consulting in the context of mergers, acquisitions, stock exchange listings for companies; financial consulting and advising related to acquisition of financial interests in commercial enterprises and companies; management and administration of portfolios of financial interests; financial consulting and expert appraisals for management of capital interests held in listed or unlisted companies; financial asset and real estate management; surety services; provision and financial management of cash savings accounts; management of financial benefits associated with the use of a loyalty card, namely, loyalty program payment processing services

**International Class(es):** 036 - Primary Class

**U.S Class(es):** 100, 101, 102

**Class Status:** ACTIVE

**Basis:** 66(a)

**For:** Technical advisory, consulting and research services in the field of equipment and installations for conducting, switching, transforming, accumulating, regulating, measuring or controlling electricity; technical advisory, consulting and research services in the field of apparatus, equipment and installations for lighting, ventilating, heating or air cooling; technical advisory, consulting and research services in the field of home automation, building automation and industrial process controls; technical research in the field of security and remote monitoring of persons and goods, industrial installations or service activities and private residences; technical project studies on evaluating requirements, namely, technical diagnostics, with respect to electrical equipment and installations, including cables, relating to heating and air cooling, home automation, building automation, industrial process controls, security and monitoring; technical consulting and technical studies to evaluate technical performance, to analyze accounting and options for integrating electrical equipment into complex electrical installations; technical design of new products and services for others in the field of electrical equipment and installations, and in the field of tools; technical project studies, analyses and diagnostics for the implementation and commissioning of electrical apparatus and installations; design and development including technical analysis of products for others and technical consulting in the choice of electrical and industrial equipment likely to meet technical requirements defined in a technical project specification; providing technical information, particularly on-line or on telecommunication and/or computer networks, with regard to electrical equipment, apparatus and installations, with regard to equipment, apparatus and installations for lighting, electrical control, heating and air-conditioning, signaling, monitoring, alarms, access control, home automation, building automation and industrial process controls

**International Class(es):** 042 - Primary Class

**U.S Class(es):** 100, 101

**Class Status:** ACTIVE

**Basis:** 66(a)

## Basis Information (Case Level)

**Filed Use:** No

**Currently Use:** No

**Amended Use:** No

**Filed ITU:** No

**Currently ITU:** No

**Amended ITU:** No

**Filed 44D:** No

**Currently 44D:** No

**Amended 44D:** No

**Filed 44E:** No

**Currently 44E:** No

**Amended 44E:** No

**Filed 66A:** Yes

**Currently 66A:** Yes

**Filed No Basis:** No

**Currently No Basis:** No

## Current Owner(s) Information

**Owner Name:** REXEL DEVELOPPEMENT SAS

**Owner Address:** 13 Boulevard du Fort de Vaux  
F-75017 PARIS  
FRANCE

**Legal Entity Type:** Société par actions simplifiée à associé unique

**State or Country Where Organized:** FRANCE

## Attorney/Correspondence Information

### Attorney of Record

**Attorney Name:** Mary Margaret L. O'Donnell

**Docket Number:** 55128-0045

**Attorney Primary Email Address:** [tmddocketing@bluefilamentlaw.com](mailto:tmddocketing@bluefilamentlaw.com)

**Attorney Email Authorized:** Yes

### Correspondent

**Correspondent Name/Address:** Mary Margaret L. O'Donnell  
Blue Filament Law PLLC  
450 N. Old Woodward Avenue  
First Floor  
Birmingham, MICHIGAN 48009  
UNITED STATES

**Phone:** 248.430.5770

**Correspondent e-mail:** [tmddocketing@bluefilamentlaw.com](mailto:tmddocketing@bluefilamentlaw.com)

**Correspondent e-mail Authorized:** Yes

### Domestic Representative

**Domestic Representative Name:** Mary Margaret L. O'Donnell

**Phone:** 248.430.5770

Domestic Representative [tmddocketing@bluefilamentlaw.com](mailto:tmddocketing@bluefilamentlaw.com)  
e-mail:

Domestic Representative Yes  
e-mail Authorized:

## Prosecution History

Date	Description	Proceeding Number
Feb. 18, 2014	FINAL DECISION TRANSACTION PROCESSED BY IB	
Jan. 21, 2014	FINAL DISPOSITION NOTICE SENT TO IB	
Jan. 21, 2014	FINAL DISPOSITION PROCESSED	68359
Jan. 01, 2014	FINAL DISPOSITION NOTICE CREATED, TO BE SENT TO IB	
Nov. 22, 2013	CHANGE OF NAME/ADDRESS REC'D FROM IB	
Oct. 01, 2013	REGISTERED-PRINCIPAL REGISTER	
Jul. 21, 2013	NOTIFICATION PROCESSED BY IB	
Jul. 16, 2013	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Jul. 16, 2013	PUBLISHED FOR OPPOSITION	
Jun. 26, 2013	NOTIFICATION OF POSSIBLE OPPOSITION SENT TO IB	
Jun. 26, 2013	NOTICE OF START OF OPPOSITION PERIOD CREATED, TO BE SENT TO IB	
Jun. 26, 2013	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jun. 11, 2013	LAW OFFICE PUBLICATION REVIEW COMPLETED	68171
Jun. 11, 2013	ASSIGNED TO LIE	68171
May 24, 2013	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 15, 2013	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
May 14, 2013	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
May 14, 2013	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
May 14, 2013	ATTORNEY REVOKED AND/OR APPOINTED	
May 14, 2013	TEAS REVOKE/APPOINT ATTORNEY RECEIVED	
Dec. 17, 2012	CORRECTION SENT TO IB	
Dec. 17, 2012	CORRECTION CREATED FOR IB	
Dec. 03, 2012	REFUSAL PROCESSED BY IB	
Nov. 14, 2012	NON-FINAL ACTION MAILED - REFUSAL SENT TO IB	
Nov. 14, 2012	REFUSAL PROCESSED BY MPU	72589
Nov. 10, 2012	NON-FINAL ACTION (IB REFUSAL) PREPARED FOR REVIEW	
Nov. 09, 2012	NON-FINAL ACTION WRITTEN	81095
Nov. 03, 2012	ASSIGNED TO EXAMINER	81095
Oct. 04, 2012	APPLICATION FILING RECEIPT MAILED	
Sep. 30, 2012	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	
Sep. 28, 2012	LIMITATION FROM ORIGINAL APPLICATION ENTERED	67445
Sep. 27, 2012	SN ASSIGNED FOR SECT 66A APPL FROM IB	

## International Registration Information (Section 66a)

International Registration Number: 1128368

Priority Claimed Flag: Yes

Intl. Registration Status: REQUEST FOR EXTENSION OF PROTECTION PROCESSED

Notification of Designation Date: Sep. 27, 2012

International Registration Renewal Date: Jul. 11, 2022

First Refusal Flag: Yes

International Registration Date: Jul. 11, 2012

Date of Section 67 Priority Claim: Jun. 11, 2012

Date of International Registration Status: Sep. 27, 2012

Date of Automatic Protection: Mar. 27, 2014

## TM Staff and Location Information



TM Staff Information - None

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location: Oct. 01, 2013

---

## Assignment Abstract Of Title Information

---

### Summary

Total Assignments: 1

Registrant: REXEL DEVELOPPEMENT SAS

---

### Assignment 1 of 1

---

Conveyance: CHANGE OF ADDRESS

Reel/Frame: 5157/0502

Pages: 2

Date Recorded: Nov. 22, 2013

Supporting Documents: assignment-tm-5157-0502.pdf

### Assignor

Name: REXEL DEVELOPPEMENT SAS

Execution Date: Sep. 10, 2013

Legal Entity Type: UNKNOWN

State or Country Where  
Organized: FRANCE

### Assignee

Name: REXEL DEVELOPPEMENT SAS

Legal Entity Type: NOT PROVIDED

State or Country Where  
Organized: NOT PROVIDED

Address: 13 BOULEVARD DU FORT DE VAUX  
F-75017 PARIS, FRANCE

### Correspondent

Correspondent Name: REXEL DEVELOPPEMENT SAS

Correspondent Address: 13 BOULEVARD DU FORT DE VAUX  
F-75017 PARIS  
FRANCE

Domestic Representative - Not Found